

REMARKS

Claims 1, 4-9 and 12-14 are presented for reconsideration and further examination in view of the following remarks. By this Response and Amendment, claim 1 and claims 4-9 have been amended, claim 11 has been canceled and claims 12, 13 and 14 are newly presented.

In the outstanding Office Action, the Examiner rejected claims 1, 4, 7, 9 and 11 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,198,189 to Takahashi et al. (hereinafter referred to as "Takahashi et al.") in view of U.S. Patent No. 6,485,028 to Smith (hereinafter referred to as "Smith"); rejected claim 8 under 35 U.S.C. § 103(a), as being unpatentable over Takahashi et al. in view of Smith and further in view of U.S. Patent No. 5,616,973 to Khazanov et al. (hereinafter referred to as "Khazanov et al."); objected to the specification for informalities and required correction; and objected to claims 4 and 11 for informalities and required correction.

Claims 1 and 4-9 have been amended, claims 12, 13 and 14 added, and claim 11 canceled, for the sole reason of advancing prosecution. Applicant, by amending or canceling any claims herein, makes no admission as to the validity of any rejection made by the Examiner against any of these claims. Applicant reserves the right to reassert the original claim scope of any claim amended or canceled herein or in a previous Response, in a continuing application.

Support for the amended claims may be found throughout the original specification, claims and figures as filed. The claims have been amended to delete the reference numbers and replace the phrasing "characterised in that" with "wherein," to conform the claims to U.S. patent practice. The dependency of claim 4 has been amended, in accordance with the Examiner's suggestion. Newly presented claims 12, 13 and 14 rewrite the Examiner indicated Allowable Subject Matter of claims 5 and 6 in independent form, including the subject matter of intervening

claims, as suggested by the Examiner.

Thus, it is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. § 132.

Objection to the Specification

The Examiner objected to the abstract of the disclosure for containing the word “comprises” at line 2 and for “not [being] in a separate page” and required correction, referring to MPEP § 608.01(b).

Response

Applicant has carefully considered the Examiner’s objection. Consequently, the abstract has been amended to replace the word “comprises” in the second line of the Abstract with the word “has.”

However, Applicant respectfully submits that the abstract of the instant application is not required by MPEP § 608.01(b) to be filed on a separate page. As stated in MPEP § 608.01(b) (*emphases added*):

The abstract must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. Form paragraph 6.16.01 (below) may be used if the abstract does not commence on a separate sheet. *Note that the abstract for a national stage application filed under 35 U.S.C. 371 may be found on the front page of the Patent Cooperation Treaty publication (i.e., pamphlet).*

Accordingly, the text in MPEP § 608.01(b) relative to form paragraph 6.16.01 states:

¶ 6.16.01 *Abstract of the Disclosure: Placement*

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Examiner Note:

1. This paragraph should only be used for applications filed on or after September 23, 1996.

2. 37 CFR 1.72(b) requires that the abstract be set forth on a separate sheet. This requirement applies to amendments to the abstract as well as to the initial filing of the application.

3. *This form paragraph should not be used during the national stage prosecution of international applications ("371 applications") if an abstract was published with the international application under PCT Article 21.*

(emphases added)

Applicant respectfully reminds the Examiner that the instant application was filed in the U.S. Patent and Trademark Office under 35 U.S.C. § 371 and that the Abstract of the instant application was provided at the time of filing of the corresponding International Application No. PCT/IB2004/003186 and printed on the title page of PCT Publication No. WO 2005/034309 A1. Accordingly, as provided for in at least MPEP § 608.01(b), the requirement for the abstract to commence on a separate page should not be applied to the instant application.

In view of the above discussed amendment and remarks, Applicant respectfully submits that the objections to the specification have been obviated and request reconsideration and an indication of the same.

Objections to the claims

The Examiner objected to claims 4 and 11 for informalities and required correction. Specifically, the Examiner objected to the phrasing of claim 4 and objected to claim 11 under 37 CFR 1.75(c), as being of improper dependent form, and required correction.

Response

As discussed above, claim 4 has been amended in accordance with the Examiner's suggestion. Specifically, the dependency claim phrasing "any of the foregoing claims" has been replaced with "claim 1."

By this Response and Amendment, the objected to claim 11 has been canceled.

Applicant respectfully submits that the above amendments obviate the Examiner's objections to the claims and request reconsideration and an indication of the same.

Rejections to the claims under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 4, 7, 9 and 11 under 35 U.S.C. § 103(a), as being unpatentable over Takahashi et al. in view of Smith and rejected claim 8 under 35 U.S.C. § 103(a), as being unpatentable over Takahashi et al. in view of Smith and further in view of Khazanov et al.

Response

By this Response and Amendment, claim 11 has been canceled without prejudice or disclaimer to the contents thereto. Accordingly, the rejection thereto is moot.

Applicant traverses the remaining rejections as all of the features of the presently claimed subject matter are not disclosed, taught or suggested by the cited prior art of record.

To establish a *prima facie* case of obviousness, the Examiner must establish that the prior art references teach or suggest all of the claim features. *Amgen, Inc. v. Chugai Pharm. Co.*, 18, USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ2d 494, 496 (CCPA 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. *See Dystar Textilfarben GMBH v. C. H. Patrick*, 464 F.3d 1356 (Fed. Cir. 2006). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 1366.

Overview

Amended independent claim 1 recites, *inter alia*, an electric motor comprising:

- a casing having a shaft on which a stator and a rotor are mounted, the casing comprising
 - a cup-shaped part,
 - a lid, wherein the cup-shaped part and the lid are connected to one another with removable connecting devices, and
 - a static seal inserted between the cup-shaped part and the lid, the static seal comprising
 - an O-ring seal positioned in a seat in the lid or in the cup-shaped part, and
 - retaining means for maintaining the application of the static seal to one of the elements, either the lid or the cup-shaped part, wherein the retaining means are rings, each ring connected to the static seal by two sections.

Takahashi et al. “relates to a motor-driven device for use in a motor-driven coolant pump device in a vehicle engine cooling system, and a motor-driven hydraulic pump device in a vehicle anti-lock braking system.” *See* Takahashi et al. col. 1, lines 12-15. The Examiner has asserted on page 3 of the Office Action that “[R]egarding claim 1, Takahashi et al. shows an electric motor comprising a casing (22) in which there is a stator and a rotor (28, 30) mounted on a shaft (20), the casing (23) comprising a cup-shaped part and a lid (13) connected to one another with removable connecting devices, and a static seal (35) inserted between the cup-shaped part and the lid.”

However, Applicant respectfully submits that Takahashi et al. shows an electric motor comprising a casing (22) in which there is a stator and a rotor (“a pair of permanent field magnets 28” and an “armature 30,” respectively) mounted on a shaft (“output shaft 20”), the casing (22) comprising a cup-shaped part (“bottomed cylindrical yoke 23”) and a lid (“annular disk-shaped end plate 25”) connected to one another with removable connecting devices, and a static seal (“packing 35 is an annular rubber ring”) inserted between the cup-shaped part and the lid (25). *See* Takahashi et al. col. 2, line 58 to col. 3, line 47 and Fig. 2.

More specifically, Applicant respectfully traverses the Examiner’s assertion that the element numbered as 13 is the lid of the casing of the motor. Applicant notes that Takahashi et al. discloses that the element numbered as 13 is “the base 13” and is a part of the “housing 17,” along with “a casing 16.” *See* Takahashi et al. col. 2, lines 53 and 54; col. 3, line 27; and Fig. 1. Applicant respectfully submits that it is evident that the lid should be interpreted as the Takahashi et al. element numbered 25. Noticeably, the element numbered as 13 is absent from Fig. 2, which otherwise depicts the relationship between the above discussed Takahashi et al. numbered elements.

Indeed, Takahashi et al. discloses that “[a] casing 22 of the motor 12 has a bottomed cylindrical yoke 23 and, an annular disk-shaped end plate 25 closing an opening 24 of the yoke 23.” *See* Takahashi et al. col. 2, lines 58-60. Similarly, Takahashi et al. discloses that “[T]he pump 11 has a housing 17 which includes a base 13 and a casing 16 having an inlet port 14 and an outlet port 15....The base 13 has a fixation surface 13a to which the motor 12 is fixed.” *See* Takahashi et al. col. 2, lines 53 to 57. Consequently, it is clear that Takahashi et al. provides for a sealing between the elements “a motor 12” and “a pump 11,” and that “the base 13” takes no part in such arrangement between the “motor 12” and “pump 11.”

Smith “relates to a cylinder head gasket for an internal combustion engine. More particularly, the invention relates to a multi-layer metal cylinder head gasket having a sealing member that floats in a cylinder opening, corresponding to a combustion chamber, of a spacer layer of the multi-layer gasket.” *See* Smith col. 1, lines 6-11.

Khazanov et al. is “generally directed to motor housing, and more specifically is directed to a pump motor housing having an improved cooling means for cooling the motor.” *See* Khazahov et al. col. 1, lines 6-10.

Rejection of claims 1, 4, 7, 9 and 11

Applicant respectfully submits that Takahashi et al. does not at all show that the static seal is inserted between the cup-shaped part and the lid. Moreover, the O-ring defining the static seal is not positioned in a seat in the lid or in the cup-shaped part, since Takahashi et al. does not show a seat. Indeed, the seal shown by Takahashi et al. is not placed between the cup-shaped part and the lid. Instead, the seal shown by Takahashi et al. is placed outside either the cup-shaped part or outside the lid. In other words, the seal shown by Takahashi et al. is placed between the flange (29) of the cup-shaped part and a fixation surface (13a) of a pump (11).

In view of figures 3 and 4 of Takahashi et al., it is clear what is intended to be the lid (25) and the cup-shaped (23) part. Accordingly, and in contrast to the presently claimed subject matter, no seal is provided between the cup-shaped part (23) and the lid (25). Therefore, Takahashi et al. fails to at least disclose “a casing having a shaft on which a stator and a rotor are mounted, the casing comprising a cup-shaped part, a lid, wherein the cup-shaped part

and the lid are connected to one another with removable connecting devices, and a static seal inserted between the cup-shaped part and the lid” as recited in claim 1.

As admitted by the Examiner on page 3 of the Office Action, Takahashi is lacking in showing all of the features recited in the claims, and specifically at least in showing “[except for] retaining means so that it remains applied to one of the elements, either the lid or the cup-shaped part; the electric motor being characterized in that the seal retaining means are rings each of that connected to the seal by two sections for the purpose of retaining the seal in place.” These features are recited in independent claim 1.

For this reason, the Examiner applied Smith, asserting that “Smith shows a retaining means (32) so that it remains applied to one of the elements; the electric motor being characterized in that the seal (15) retaining means (32) are rings each of that connected to the seal (15) by two sections (Figures 2 and 3) for the purpose of retaining the seal in place.” However, Smith is also not directed to “*a casing having a shaft on which a stator and a rotor are mounted, the casing comprising a cup-shaped part, a lid, wherein the cup-shaped part and the lid are connected to one another with removable connecting devices, and a static seal inserted between the cup-shaped part and the lid,*” (emphases added) as recited in the claims. Indeed, Smith is silent, does not disclose, teach or suggest, and is thus non-enabling with regard to these features, *inter alia*.

Therefore, even *assuming arguendo* that Smith showed the retaining means comprising rings, each connected to the seal by two sections to retain the seal in place, as asserted by the Examiner, as Smith has not been used to show “*a casing having a shaft on which a stator and a rotor are mounted, the casing comprising a cup-shaped part, a lid, wherein the cup-shaped part and the lid are connected to one another with removable connecting devices,*

and a static seal inserted between the cup-shaped part and the lid,” as recited in the claims, neither Smith nor the combination of Takahashi in view of Smith can cure the deficiencies of Takahashi. It is respectfully submitted that Takahashi et al. in view of Smith would not lead a person having ordinary skill in the art to the solution as described in the presently claimed subject matter. The combination of the cited prior art *fails* at least because the position of the seal and the fact that the seal is placed in a seat on the lid or on the cup-shaped body are not disclosed, taught, or suggested by the cited prior art.

In view of the above discussion, Applicant respectfully submits that claim 1 is non-obvious and patentable over the cited prior art (Takahashi et al. and Smith). Therefore, in view of the foregoing, reconsideration and withdrawal of the above rejection against claim 1 is respectfully requested.

As claims 4, 7 and 9 (indeed, claims 4-9) depend from claim 1, Applicant asserts that claims 4-9 (including rejected claims 4, 7 and 9) are allowable for at least their dependency from patentable claim 1, as well as for additional features recited therein.

As discussed above, by this Amendment, claim 11 has been canceled without prejudice or disclaimer to the contents thereto; accordingly the rejection of claim 11 is moot.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

Rejection of claim 8

The Examiner has relied on Khazanov et al. to cure the deficiencies of Takahashi et al. and Smith and asserted that “[r]egarding claim 8, the machine of Takahashi et al. modified by Smith includes all of the limitations of the claimed invention including the rings (30) being

integral with the seal (15) *except* for the seal being made of elastomeric material. Khazanov et al. shows the seal (52) being made of elastomeric material of the purpose of increasing tightness” (emphasis added). See page 5 of the Office Action.

However, Khazanov et al. is also **not** directed to “*a casing having a shaft on which a stator and a rotor are mounted, the casing comprising a cup-shaped part, a lid, wherein the cup-shaped part and the lid are connected to one another with removable connecting devices, and a static seal inserted between the cup-shaped part and the lid,*” (emphases added) as recited in the claims.

Accordingly, Khazanov et al. fails to cure the deficiencies of Takahashi et al. and Smith with respect to “*a casing having a shaft on which a stator and a rotor are mounted, the casing comprising a cup-shaped part, a lid, wherein the cup-shaped part and the lid are connected to one another with removable connecting devices, and a static seal inserted between the cup-shaped part and the lid,*” as recited in independent claim 1 (emphases added) and discussed above.

Accordingly, the cited combination of Takahashi et al., Smith and Khazanov et al., whether individually or in combination, fails to disclose, teach, or suggest, at least, “*a casing having a shaft on which a stator and a rotor are mounted, the casing comprising a cup-shaped part, a lid, wherein the cup-shaped part and the lid are connected to one another with removable connecting devices, and a static seal inserted between the cup-shaped part and the lid,*” as recited in amended independent claim 1 (emphases added).

Takahashi et al., Smith and Khazanov et al. have been discussed above and each of these references does not disclose the features of claim 1 of the presently claimed subject matter. In addition, the combination of Takahashi et al., Smith and Khazanov et al. has been discussed

above and does not disclose the features of claim 1 of the presently claimed subject matter. Thus, Applicants respectfully submit that as none of the cited prior art has disclosed, taught or suggested the above features of the independent claim, such a claim is unobvious and therefore patentable.

As claim 8 depends from claim 1, Applicant asserts that claim 8 is allowable for at least its dependency from patentable claim 1, as well as for additional features recited therein.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection.

Newly presented claims 12-14

Applicant respectfully submits that newly presented claim 12 is patentable over the cited prior art, whether alone or in combination. Indeed, none of the cited documents shows that fixing means presented in the lid or in the cup-shaped part comprises pins.

Indeed, in particular Smith shows the fixing means represented by the channel (25) in which the retaining means are placed in, but it does not show at all any pin which the rings of the retaining means are placed around. So, Applicant believes that newly introduced claim 12 is new and non obvious over the prior art.

Regarding newly introduced claim 13, in Applicant's opinion this claim is patentable over the available prior art at least for the reasons stated above when discussing about claim 12. Moreover, it is to be noted that claim 13 contains all the subject matter of original claims 1, 4 and 5. Such a combination has been considered as allowable subject matter by the Examiner.

Allowable Subject Matter

The Examiner has indicated that claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner has further provided a statement of reasons for the indication of allowable subject matter.

Response

Applicant thanks the Examiner for his careful consideration of the claims and indication of Allowable Subject Matter. Applicant has followed the Examiner's suggestions and indication of allowable subject matter in the above discussed claim amendments.

With this Response, Applicant presents new claims 12, 13 and 14. Claim 13 rewrites the Examiner indicated allowable subject matter of claim 5 in independent form, including the claimed subject matter of independent claim 1 and dependent claim 4. Similarly, claim 14 rewrites the Examiner indicated allowable subject matter of claim 6 in independent form, including the claimed subject matter of independent claim 1 and dependent claim 4. Claim 12 presents the subject matter of independent claim 1 and dependent claim 4 in revised independent claim form, including subject matter claimed in Examiner indicated allowable claim 5 and 6 of "said fixing means comprises pins."

Accordingly, Applicant requests an early indication of allowability of the above discussed claims.

CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner call the undersigned attorney(s).

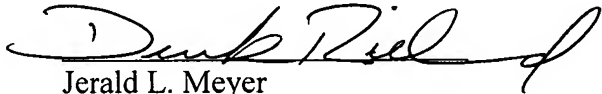
In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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